

2/20/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 11
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Lanny Bassham, dba Mental Management Systems**

Serial No. 75/606,101

Lawrence A. Maxham of Baker & Maxham for **Lanny Bassham, dba Mental Management Systems**.

Zhaleh S. Delaney, Trademark Examining Attorney, Law Office 101 (Jerry Price, Managing Attorney).

Before Hanak, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Lanny Bassham, dba Mental Management Systems has filed an application to register the mark MENTAL MANAGEMENT on the Principal Register for "educational services, namely, conducting classes, seminars, conferences, and workshops in the field of personal performance enhancement in preparation for competition" in International Class 41; and "counseling in the field of personal performance enhancement in preparation for competition" in International Class 42. The application was filed on

December 11, 1998, based on applicant's claimed dates of first use and first use in commerce for both classes of January 1976.

In the first Office action, the Examining Attorney, inter alia, refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the grounds that (i) the mark MENTAL MANAGEMENT is generic of applicant's services, and (ii) when used in connection with applicant's identified services, is merely descriptive of them. Following consideration of applicant's response thereto, the Examining Attorney made both refusals to register final.

In support of her refusals, the Examining Attorney had submitted dictionary definitions of the word "mental" and "management"; several excerpted stories from the Nexis database referring to "mental management" or "mental control"¹; and several pages from different websites,

¹ We note that many of the Nexis excerpts were repetitive or were not pertinent as explained below. In this case, some of the excerpted stories indicate uses of the searched words "mental management" or "mental control" in relation to unrelated matters such as, "environ-mental management," and the escape artist Houdini. Thus, those are of limited probative value in relation to applicant's educational and counseling services. Others are from wire services, and thus are of limited probative value in assessing the reaction of the public to the term applicant seeks to register because evidence from a proprietary news service is not presumed to have circulated among the general public; and some of the excerpted stories appeared in foreign publications (e.g., New Zealand, Australia), and are of limited probative

including applicant's; as well as relying on applicant's specimens of record.

Applicant timely appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

In his brief on appeal, applicant framed the issue before the Board as "The main question for determination by the Board is whether a mark, the rights to which have been long established by continuous use, can be destroyed by casual misuse by careless journalists more than 20 years later." (p. 2) Applicant did not mention the genericness refusal, but argued that the mark is suggestive, and also specifically argued as follows:

"I. Even assuming that MENTAL MANAGEMENT could have been deemed to be descriptive in 1976, the mark had acquired secondary meaning long before the present application was filed due to more than two decades of exclusive use" (p. 3); and

"V. The effect of secondary meaning. Where there is undisputed proof of secondary meaning, some courts do not even inquire whether or not the mark was originally descriptive. (McCarthy 11:25, page 11-48). Here there is

value because it cannot be assumed that foreign uses had any material impact on the perceptions of the public in the United States. See *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992); and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986). In addition, some of the excerpts were printouts of identical stories.

indeed undisputed proof of secondary meaning." (p. 8)

Applicant then pointed out his use of the mark since 1976 (supported by applicant's declaration), and "seven statements by unrelated third parties" evidencing applicant's long use and recognition of the mark by the consuming public.

In her brief on appeal (p. 14), the Examining Attorney withdrew the refusal based on genericness. It is not clear, but it appears that the Examining Attorney did not consider applicant's arguments or evidence regarding acquired distinctiveness, explaining that applicant raised this for the first time in his appeal brief, and that applicant never made a "formal" and "proper" Section 2(f) claim.² To whatever extent she did consider the evidence, she apparently found it insufficient because she stated

² There is no requirement in the Trademark Act, the Trademark Rules of Practice or the TMEP that applicant must file a "formal" request for registration under Section 2(f). See *In re Advanced Spine Fixation Systems Inc.*, 25 USPQ2d 1363, footnote 3 (TTAB 1992); *In re Advanced Spine Fixation Systems Inc.*, 25 USPQ2d 1367, 1369 (TTAB 1992); and *In re DeSoto, Inc.*, 172 USPQ 497 (TTAB 1972). In the case now before us, the Examining Attorney specifically stated in both the first Office action and the Final Office action that she could not recommend an amendment to proceed under Section 2(f). The seven signed letters from the public and applicant's declaration regarding his use of the mark since 1976 were submitted prior to applicant's appeal; and applicant was clearly asserting a claim of distinctiveness in his brief.

applicant does not have exclusive use³ of the terms "mental management."

In his reply brief (p. 3), applicant stated that "As to the 2(f) showing which was abundantly made, Applicant hereby *formally* requests registration under Section 2(f) of the Act." (Emphasis in original.) Applicant did not present his request for registration under Section 2(f) as an alternative position. Moreover, we find a fair and reasonable reading of his overall brief and reply brief substantiate that applicant's request is not an alternative request, but rather is a straightforward request to register his mark pursuant to Section 2(f) of the **Trademark Act**.

In view of applicant's request for registration under Section 2(f) of the **Trademark Act**, we need not reach the descriptiveness issue in this case. We will determine the sufficiency of applicant's evidence to establish a prima facie showing that his mark has acquired distinctiveness. See *In re Capital Formation Counselors, Inc.*, 219 USPQ 916 (TTAB 1983).

Applicant has the burden of establishing a prima facie case that his mark has become distinctive. See *Yamaha*

³ Section 2(f) of the **Trademark Act** refers to use which is "substantially exclusive."

International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally, the more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *Yamaha*, supra at 1008. See also, 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §15:28 (4th ed. 2000). Therefore, the amount of evidence required to establish acquired distinctiveness of applicant's mark depends on the nature of his mark.

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive⁴ and those which are suggestive, and the borderline between the two is hardly a clear one. See *In re Atavio Inc.*, 25

⁴ It is well settled that "a term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]" (emphasis added). *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, the immediate idea must be conveyed with a "degree of particularity." *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Entenmann's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd*, *unpub'd*, Fed. Cir. February 13, 1991. Whereas, a mark is suggestive if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980).

USPQ2d 1361 (TTAB 1992). Because we believe on this ex-parte record, that the applied-for mark is on this thin line of demarcation between suggestive and merely descriptive, the kind and amount of evidence necessary for applicant to establish a prima facie showing of acquired distinctiveness is lessened.

In the case before us there is only minimal evidence of third-party uses of the words "mental management," and from the third-party uses of record, it is clear that the words "mental management" may refer to various things related to the mind, including mental stress, mental control or mental problems, etc. Moreover, applicant has established over twenty years of use of his mark for his identified services, and he submitted seven individualized letters from people who have purchased and utilized his services, all of them attesting to, inter alia, their recognition of applicant's mark, MENTAL MANAGEMENT, as referring specifically and only to applicant, Lanny Bassham. One of the seven customers had first attended one of applicant's seminars in 1977.

In view of the nature of this mark, we find applicant's evidence demonstrates, at least prima facie, that these words have become distinctive of applicant's services.

Finally, and in accordance with precedent, we must resolve any reasonable doubt in favor of applicant in these kinds of cases. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).

Decision: The refusal to register the mark under Section 2(e)(1) is reversed in view of applicant's prima facie showing of acquired distinctiveness, and the application will proceed to publication with a notation of applicant's claim of acquired distinctiveness under Section 2(f).